

REMARKS

Claims 1-7 are pending in the present application.

I. PRIOR ART REJECTION

Claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,201 (Tso). This rejection is traversed.

The Examiner's reasoning for the rejection is substantially similar to that presented in the previous office action dated August 20, 2003. One difference is the addition of the Examiner's argument that the reply e-mail of Tso includes at least one or more portions of the received e-mail (see page 3, lines 15-16 of the Office Action). The Examiner relies on column 2, lines 59-67 of Tso for this alleged teaching of Tso.

Applicant submits that this section of Tso does not teach or suggest to use portions of the received e-mail in the reply e-mail, and certainly does not teach or suggest having a user select portions of a received mail and coupling the user selected portions of the received mail with answer examples, as recited in the claimed invention. In the system

taught by Tso, the **entire contents** of the replay mail is formed from the **template** (see column 5, line 66 – column 6, line 33). Tso only teaches to use the contents of the received e-mail to **choose the template** (see column 4, line 33 – column 5, line 53). Portions of a received e-mail are **not** selected by the user, and are not coupled with answer examples such that the contents of the received e-mail are inserted into the reply e-mail.

In the Examiner's response to Applicant's Remarks presented on page 4 of the Office Action, the Examiner asserts:

One of ordinary skill in the art would argue that the generated text message **could in fact** contain actual content portions directly received from the input text string and does not exclude such portions. In the example provided in Fig. 4 and column 6, lines 6-65, one of ordinary skill in the art would agree that when a template is chosen which "enables a user to compose text messages using dramatically fewer keystrokes than otherwise be required" (see col. 6, lines 25-27), contents or portions from the received e-mail that is parsed is included in the reply e-mail. [emphasis added].

Applicant submits that the statement that one skilled in the art would argue that the generated text message "could in fact contain" is completely irrelevant to an anticipation rejection under 35 U.S.C. § 102. The **only issue** is what the reference discloses. A proper rejection under 35 U.S.C. § 102 must demonstrate that Tso discloses all of the claim elements. Since Tso does not teach the above noted feature of the claimed invention, the rejection under 35 U.S.C. § 102(e) is improper.

The Examiner appears to be arguing that the claimed invention is inherent in Tso. If so, this argument will also fail because in order to support an inherency argument, Tso must necessarily operate in the claimed manner (see *In re King*, 231 USPQ 136, 8 (Fed. Cir. 1986)). There is no indication in Tso that a user must pick from one or more portions of a received e-mail, and that the reply e-mail must include one or more portions of the received e-mail. Quite to the contrary, Tso merely teaches to create the outgoing text message using templates that are selected based upon the input text message (see column 4, line 32 – column 5, line 17). The Examiner's chosen language "could in fact" means something that is only possible or probable.

Applicant maintains that Tso does not teach or suggest a system that performs the functions of: (1) requiring a user to select one or more portions from a received mail; and (2) coupling the selected contents of the received mail with selected answer examples.


Therefore, for the reasons presented above, Applicant submits that the Examiner has misread the Tso reference and that Tso does not anticipate claims 1-7. Therefore, Applicant submits that the rejection of

claims under 35 U.S.C. § 102(e) is improper and respectfully request that it be withdrawn.

Based on the foregoing, Applicant submits that the present application is in condition for allowance and allowance is respectfully solicited. If the Examiner believes that the prosecution of this case could be expedited through a telephone interview, he is kindly invited to contact the undersigned at the phone number listed below.

Applicant believes that no additional fees are due for the subject application. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully Submitted,



John J. Penny, Jr.
(Reg. No.: 36,984)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, Ma 02205
Tel: (617) 517-5549
Fax: (617) 439-4170

Date: June 24, 2004

Customer No.: 21874